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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,376	02/27/2002	Daisuke Miyakoshi	112066	4770

25944 7590 07/30/2003

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EXAMINER

TO, TUAN C

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/083,376

Applicant(s)

MIYAKOSHI ET AL.

Examiner

Tuan C To

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6049718A) and in view of Yen (US Patent Application Publication No. 20030036389A1).

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Claims 1, 4, 13, 14, and 16: With respect to the subject matter of those claims, Stewart is directed to a telephone system and method with background location response capability, comprising: a main storage 48, and location code storage where the location code is stored (see figure 2, 50), a receive unit for receiving location information (see figure 2, 40). In addition, Stewart summarizes in the abstract that an audio or visual user output device which can produce audio or visual information in an incoming call signal as a corresponding audio or visual display; and an audio user input device which generates an audio output signal corresponding to a user's voice in which the audio or video data stored in the main storage unit are retrieved when the incoming calls arrive. Stewart does not disclose that the storage unit for correlating and storing location information and data. Yen is directed to a wireless system in which the wireless terminal stores the location along with associated location dependent operating parameter (see abstract). And when the terminal is located within a predetermined distance from the previous stored location, the valid data is generated based on the current location is within the stored location. It would have been obvious to one having ordinary skill in the art to combine the Stewart's and Yen to achieve the overall system of the present invention. The advantage of the modified system is to provide any location related data such as address, friends' telephone numbers etc. to users immediately as needed when said users travel to that location.

Claim 2: As mentioned above, the teaching of main storage, location code storage taught by Stewart would be combined with the teaching of retrieving the data or

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information are previously stored at one specific location in order to address the feature as claimed.

Claim 3: Stewart discloses a visual display for reproducing either video data or audible data previously stored at a specific location.

Claims 5, and 15: It should be noted that the combination of Stewart and Yen disclose the all features recited in claim 5 and 15 of the present invention. The details have been discussed in the preceding paragraphs.

Claim 6: In Stewart's, the numeral reference 36 of figure 2 is either an audio or visual display provided sound or image respectively to users.

Claims 7-9: As shown in figure 2 of Stewart, the location storage 50 as indicative to store the location code for each location.

Claims 10-12: As mentioned in the patent, the GPS receiver acts as the position detector for detecting the position of the terminal unit.

Claims 17-21: The mention-above prior art show that the combination of Stewart and Yen disclose a storage medium storing a program for enabling a computer to execute a method of receiving location data, instructing the computer to store data, and storing and correlating when the instruction is made at the instructing step, the data and the location information received at the receiving step.

### ***Response to Amendment***

This office action is a communication to respond the applicant's argument that Stewart alone would not disclose the feature as claimed in the invention. The examiner has found the new reference to Yen discloses the "correlating" process as recited in the

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claimed invention. It is important to provide Yen as the secondary reference to combine with Stewart in order to address all recitation.

In response to the applicant that Stewart does not disclose a portable information terminal including a storage unit, a receive unit, an extract unit and an information notification unit as claimed in the present invention, the examiner has showed out and discussed the roles of such the devices taught in the patent (See the details in the previous paragraph).

### ***Conclusion***

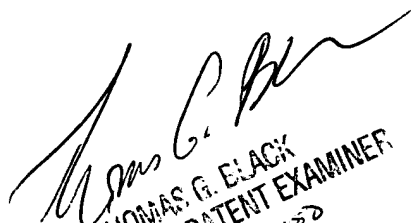
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (703) 308-6273. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (703) 305-8233. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and none for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

/tc

July 17, 2003

  
THOMAS G. BLACK  
SUPERVISORY PATENT EXAMINER  
GROUP 3020